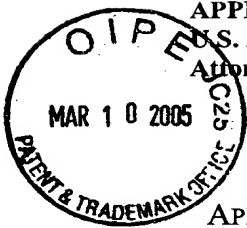


APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37
U.S. Application Serial No. 09/754,378
Attorney Docket No. 031792-0311531 (24122-303-407)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT APPLICATION OF: Craig W. BARNETT *et al.*
SERIAL NO.: 09/754,378
ATTORNEY DOCKET NO: 031792-0311531 (24122-303-407)
FILING DATE: January 5, 2001
ART UNIT: 3622
EXAMINER: A. DURAN
FOR: METHOD AND SYSTEM FOR ELECTRONIC DISTRIBUTION OF PRODUCT REDEMPTION COUPONS

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

Further to the Notice of Appeal filed on **August 10, 2004**, Appellants respectfully submit Appellants' Brief on Appeal pursuant to 37 C.F.R. §41.37.

Appellants have filed concurrently herewith a petition for a five-month extension of time. 37 C.F.R. §1.17(a)(5). The Director is authorized to charge \$1,330.00 to cover the \$1,080.00 petition fee, as well as the \$250.00 small entity fee for filing an Appeal Brief pursuant to 37 C.F.R. §41.20(b)(2). The Director is further authorized to charge any additional fees that may be due, or credit any overpayment of same to Deposit Account No. 033975 (Ref. No. 031792-0311531).

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REQUIREMENTS OF 37 C.F.R. §41.37

I. REAL PARTY IN INTEREST - 37 C.F.R. §41.37(c)(1)(i)

The real parties in interest are Black Diamond CCT Holdings, LLC., and E-centives, Inc.

II. RELATED APPEALS AND INTERFERENCES - 37 C.F.R. §41.37(c)(1)(ii)

A. Judicial Proceedings – U.S. Patent Nos. 6,321,208 and 6,336,099

This application is a continuation of U.S. Patent Application Serial No. 08/425,185, filed April 19, 1995, and issued as U.S. Patent No. 6,321,208, on November 20, 2001. U.S. Patent No. 6,321,208 as well as U.S. Patent No. 6,336,099 (which is also a continuation of U.S. Patent No. 6,321,208, and which issued on January 1, 2002) are currently the subject of pending litigation in the United States District Court for the District of Maryland Southern Division (Civil Action No. RDB-02-3701).

A Memorandum and Order Regarding Patent Claim Construction was issued on December 16, 2003, and is included herewith as **Exhibit A**.

A Summary Judgment order was issued on February 18, 2005, and is included herewith as **Exhibit B**.

B. Related Appeals

(1) U.S. Patent Application Serial No. 09/321,597, filed May 28, 1999, is a continuation of U.S. Patent No. 6,321,208. A Notice of Appeal was filed in this Application on August 10, 2004.

(2) U.S. Patent Application Serial No. 09/543,735, filed April 5, 2000, is a continuation of U.S. Patent No. 6,321,208. A Notice of Appeal was filed in this Application on August 10, 2004.

(3) U.S. Patent Application Serial No. 09/451,558, filed December 1, 1999, is a continuation of U.S. Patent No. 6,336,099 (which is a continuation of U.S. Patent No. 6,321,208). A Request for a Declaration of Interference with U.S. Patent No. 5,845,259 to West *et al.* is currently being sought. A Notice of Appeal was filed in this Application on August 10, 2004.

(4) U.S. Patent Application Serial No. 09/537,793, filed March 29, 2000, is a continuation of U.S. Patent No. 6,321,208. A Request for a Declaration of Interference with U.S. Patent No. 5,907,830 to Engel *et al.* is currently being sought. A Notice of Appeal was filed in this Application on August 10, 2004.

(5) U.S. Patent Application Serial No. 09/879,823, filed June 12, 2001, is a continuation of U.S. Patent No. 6,321,208. A Request for a Declaration of Interference with U.S. Patent No. 6,075,971 to Williams *et al.* is currently being sought. A Notice of Appeal was filed in this Application on August 10, 2004.

(6) U.S. Patent Application Serial No. 09/879,825, filed June 12, 2001, is a continuation of U.S. Patent No. 6,321,208. A Request for a Declaration of Interference

with U.S. Patent No. 6,076,069 to Laor is currently being sought. A Notice of Appeal was filed in this Application on August 10, 2004.

(7) U.S. Patent Application Serial No. 10/871,381, filed June 21, 2004, is a continuation of U.S. Patent No. 6,321,208. A Request for a Declaration of Interference with U.S. Patent No. 6,584,448 to Laor is currently being sought. A First Office Action has not yet been received.

III. STATUS OF CLAIMS - 37 C.F.R. §41.37(c)(1)(iii)

Pending: Claims 76-112 are pending.
Cancelled: Claims 1-75 are cancelled.
Rejected: Claims 76-112 stand rejected.
Allowed: No claims have been allowed.
On Appeal: Claims 76-112 are appealed.

IV. STATUS OF AMENDMENTS - 37 C.F.R. §41.37(c)(1)(iv)

No amendments have been filed subsequent to the mailing of the Final Office Action on June 22, 2004 (hereinafter "Final Action").

V. SUMMARY OF CLAIMED SUBJECT MATTER - 37 C.F.R. §41.37(c)(1)(v)

One aspect of Appellants' invention relates to a system and method for viewing and printing at a remote terminal user-specific incentives. According to an embodiment of the invention, incentive information pertaining to a group of available incentives may be stored at an Internet-accessible location. For example, an online service provider (2) may comprise a repository of electronically stored coupon data. Online service provider (2)

may refer to any computer-based service provider which is accessible by a remote personal computer user via a communications data link (*e.g.*, the public switched telephone network (PSTN) or the like). *See* Specification, *e.g.*, pg. 14, lines 18-28; and pg. 32, lines 16-18. Online service provider (2) may store in a database (40) (see FIGS. 6 and 10) various packages of electronic coupon data. *See* Specification, *e.g.*, pg. 15, lines 12-14.

According to an embodiment of the invention, user profile information and user usage history information for one or more users may also be stored. Online service provider (2) comprises, *inter alia*, a demographic data file (42) and a coupon packages file (40). Demographic data file (42) stores user-specific data (*e.g.*, one or more of coupons selected data, coupons deleted data, coupons printed data, and/or user demographics). *See* Specification, *e.g.*, pg. 15, lines 18-21. Individual users' coupon data packages are drawn from coupon packages file (40) based on demographic data and historic data stored in the demographic data file (42). *See* Specification, *e.g.*, pg. 18, lines 28-30.

According to an embodiment of the invention, the Internet-accessible location may receive, from a user of a remote terminal, a request for access to the stored incentive information. Online service provider (2) may be connected with a data link (4), and may thus be accessible by any remote personal computer (6) having a data communications interface (20) (*e.g.*, a modem) (see FIG. 2). Online service provider (2) communicates with a personal computer (6) to transmit requested coupon data, and to receive coupon requests and user-specific data. *See* Specification, *e.g.*, pg. 15, line 27 – pg. 16, line 3.

According to an embodiment of the invention, a determination may be made at the Internet-accessible location as to whether the user is a registered user. If the user is not registered, a prompt is transmitted to the user's remote terminal to electronically complete a user profile. The user profile may be received and stored, and an incentive data

management software module may be downloaded to the user's remote terminal for managing the printing of incentives. A printed incentive may include unique user identification information. For example, when a user initially registers, a dialog may be initiated with online service provider (2) such that online service provider (2) may request certain information (*e.g.*, demographic data) from the user which can be used to target specific coupon data packages. A coupon management program is also transmitted electronically to the user's computer (6) for subsequent coupon data functions. *See* Specification, *e.g.*, pg. 18, lines 4-14. In addition to the usual coupon information found on coupons the coupons (18) of the invention may also contain user-specific data. This data may be in the form of a unique user bar code (90) (*see* FIG. 5). The user bar code (90) may be encoded with user-specific information such as the user name and/or other unique identifier. This information, in part, renders each printed coupon (18) unique. *See* Specification, *e.g.*, pg. 16, line 22 – pg. 17, line 1.

According to an embodiment of the invention, if a determination is made that the user is registered, the user may then view a subset of incentives from the group of available incentives. The subset of incentives may be based on user-specific information. For example, the information may include at least one of user profile information and/or user usage history information. Individual users' coupon data packages may be drawn from coupon packages file (40) based at least in part on demographic data and/or historic use information stored in the demographic data file (42). *See* Specification, *e.g.*, pg. 18, lines 28-30. A user may select (*e.g.*, via a view function button (52) or otherwise) to view the coupons. This functionality may be performed either offline (*see* Specification, *e.g.*, pg. 21, lines 11-17; and pg. 22, lines 21-23) or online (*see* Specification, *e.g.*, pg. 33, lines 1-4).

According to an embodiment of the invention, a user may select one or more incentives from the subset of incentives for printing. Each of the one or more incentives may comprise various fields, including a redemption amount field and at least one other field. The redemption amount field comprises data indicative of a discount provided by the incentive, while the at least one other field is determined in accordance with user-specific information associated with the requesting user. The user may view the coupons selected from a selected coupon data file (30b), and may choose any of them for printing. *See* Specification, *e.g.*, pg. 23, lines 9-11. As recited above, in addition to the usual coupon information found on coupons (*e.g.*, redemption amount, company and product name, expiration date, *etc.*), the coupons (18) of the preferred embodiment of the present invention contain user-specific data. A user bar code (90) may be encoded with user-specific information. This information, at least in part, renders each printed coupon 18 unique, since an otherwise similar coupon presented by a different consumer will comprise a different user bar code (90). *See* Specification, *e.g.*, pg. 16, line 22 – pg. 17, line 1.

According to an embodiment of the invention, one or more of the user-selected incentives (which can be redeemed by a user) are printed at the remote terminal under control of the incentive data management software module. For example, the remote personal computer (6) can have connected thereto a printer (8), which may be any type of computer printer capable of printing graphics. The printer (8) is instructed by the coupon data management routines (32) stored in the computer (6) to print printed coupons (18). *See* Specification, *e.g.*, pg. 16, lines 5-9.

According to one embodiment, information regarding printed incentives is stored at the Internet-accessible location. Redemption information is also stored subsequent to a user redeeming one or more of the printed incentives. The system (*e.g.*, via a coupon

upload routine (32cc)) may keep a record indicative of each coupon selected by the user and each coupon printed by the user. This record may be stored (*e.g.*, in demographic data file (42)) in the online service provider (2), and can be used for marketing analysis along with data regarding which coupons were actually redeemed. *See* Specification, *e.g.*, pg. 24, line 26 – pg. 25, line 5.

According to an embodiment of the invention, at least incentive redemption data is provided to at least one incentive distributor or incentive issuer to enable the at least one incentive distributor or incentive issuer to use at least the incentive redemption data for market analysis to create at least one subsequent targeted incentive targeted based on targeting criteria. The at least one subsequent incentive may then be made available to a user if the user satisfies the targeting criteria. Coupon distributor (16) may collect information from online service provider (2) regarding the coupon data selected by the user, and/or the coupon data printed by the user, and may store this information along with requested demographic information in a database (11). Database (11) may also store information from the coupon redemption center (13) regarding the coupons actually redeemed by the user. Database (11) may further store information regarding all coupons which are made available by the various coupon issuers (14) from which it will generate coupon data packages for subsequent downloading to users. *See* Specification, *e.g.*, pg. 29, lines 1-12.

Information stored in database (11) can be input to (or otherwise used by) the marketing and targeting analysis mechanism (17). This mechanism may carry out the function of analyzing the aforementioned information to determine different targeted coupon packages. As an illustrative example, it may be determined by the analysis mechanism (17) that users with dogs in their household (which is known by the

demographic responses) will get a certain package comprising dog food coupons. It may be further determined that users who select, print and redeem dog food coupons of Brand X will get coupons issued by Brand Y, or will get only low value coupons since they are already dog food coupon users, *etc.* That is, depending on the marketing and targeting criteria and objectives, the analysis mechanism (17) will generate coupon packages as desired. *See* Specification, *e.g.*, pg. 29, lines 14-27.

Thus, the analysis mechanism (17) generates a number of differing coupon data packages for use by online service provider (2). The analysis mechanism (17) also provides specific mapping information which will instruct the online service provider as to which user should be provided with which package(s). For example, user 1 may be mapped to coupon data packages 2 and 3; user no. 2 to packages 3 and 6, *etc.* This mapping function may be carried out by the coupon distributor (16) (or otherwise) and provided to online service provider (2) (*e.g.*, at regular intervals such as, for instance, once per week). Thus, the coupon selection, printing and redemption habits may be analyzed over a time period and used to determine the subsequent targeted packages. *See* Specification, *e.g.*, pg. 29, line 29 – pg. 30, line 10.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL - 37 C.F.R. §41.37(c)(1)(vi)

A. Claims 82 and 91 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *See* Final Action, pg. 3, ¶5.

B. Claims 76-112 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,227,874 to Von Kohorn, in view of U.S. Patent No. 5,734,823 to Saigh *et al.* ("Saigh"). See Final Action, pg. 4, ¶6.

Appellants note the rejection of claims 76-112 under the judicially created doctrine of obviousness-type double patenting over claims 63-74 of co-pending Application Serial No. 09/321,597, as well as the rejection of claims 76-81 and 83-89 under the judicially created doctrine of obviousness-type double patenting over claims 1-8 of U.S. Patent No. 6,321,208. See Final Action, at pgs. 2-3.

Although Appellants disagree with the double-patenting rejections set forth by the Examiner, Appellants will not address these rejections in the Appeal Brief. Rather, Appellants will file a terminal disclaimer upon the indication of allowable subject matter. Appellants further note that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d (BNA) 1392 (Fed. Cir. 1991). The court indicated that the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection."

VII. ARGUMENTS - 37 C.F.R. §41.37(c)(1)(vii)

Each rejection should be reversed for the reasons set forth herein.

A. Claims 82 and 91 are supported by the Specification.

Claims 82 and 91 are supported by the Specification and satisfy the requirements of 35 U.S.C. §112, first paragraph.

35 U.S.C. §112, first paragraph recites:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

To satisfy the written description requirement of 35 U.S.C. §112, first paragraph, an applicant must “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the ‘written description’ inquiry, *whatever is now claimed*.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-1564, 19 U.S.P.Q. 2d (BNA) 1111, 1117 (Fed. Cir. 1991) (emphasis in original).

To satisfy the written description requirement, it is not necessary for the claimed subject matter to be described in haec verba in the specification. *University of Rochester v. G.D. Searle & Co., Inc.*, 358 F.3d 916, 922-923, 69 U.S.P.Q. 2d (BNA) 1886, 1892 (Fed. Cir. 2004). Rather, “the written description requirement can be satisfied by ‘words, structures, figures, diagrams, formulas, etc.’” *Koto Manufacturing Co., Ltd. v. Turn-Key-Tech, LLC*, 381 F.3d 1142, 1154, 72 U.S.P.Q. 2d (BNA) 1190, 1199 (Fed. Cir. 2004) (quoting *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572, 41 U.S.P.Q. 2d (BNA) 1961, 1966 (Fed. Cir. 1997)).

For each claim element identified by the Examiner, Appellants have provided below exemplary citations to the Specification and/or drawing figures where support can

be found. It should be understood, however, that the citations set forth are not exclusive. The Specification discloses numerous embodiments, and various system elements disclosed therein may perform various functions, or be coupled with one or more other system elements to perform various functions depending on the embodiment. As such, the following citations should not be viewed as limiting.

1. Claim 82.

Claim 82 satisfies the requirements of 35 U.S.C. §112, first paragraph. In the Final Action, at pgs. 3-4, the Examiner erroneously alleges that the Specification does not disclose that an incentive “... *is provided to the user via an electronic mail message.*” This claim language is supported as evidenced by the specification and drawings.

Support for this claim element may be found in *at least* the following exemplary citations to the Specification and/or drawing figures: FIG. 1; pg. 8, lines 11-15; pg. 10, lines 11-12 & 27-29; pg. 14, line 23 → pg. 15, line 8; pg. 15, line 27 → pg. 16, line 3; and page 20, lines 8-14. As such, this rejection is improper and should be reversed.

2. Claim 91.

Claim 91 satisfies the requirements of 35 U.S.C. §112, first paragraph. In the Final Action, at pg. 4, the Examiner erroneously alleges that the Specification does not disclose the feature “...*wherein downloading the incentive data management software module comprises downloading the unique identifier.*” This claim language is supported as evidenced by the specification and drawings.

Support for this claim element may be found in *at least* the following exemplary citations to the Specification and/or drawing figures: FIG. 1; and pg. 32, lines 20-29. As such, this rejection is improper and should be reversed.

B. Claims 76-112 are Patentable Under 35 U.S.C. §103(a)

The Examiner legally erred in rejecting claims 76-112 under 35 U.S.C. §103(a) over U.S. Patent No. 5,227,874 to Von Kohorn in view of U.S. Patent No. 5,734,823 to Saigh *et al.* ("Saigh"). Claims 76-112 are patentable for *at least* the reasons that: (1) the Examiner relies on non-analogous art for the rejection of claims 76-112; (2) assuming arguendo that the art is not deemed non-analogous, there is no legally proper teaching, suggestion, or motivation to modify Von Kohorn to include the teachings of Saigh; and (3) assuming arguendo that there was a legally proper teaching, suggestion, or motivation to combine Von Kohorn and Saigh, the references, even if combined, fail to disclose, teach, or suggest all of the claim elements.

"The foundational facts for the *prima facie* case of obviousness are: (1) the scope and content of the prior art; (2) the difference between the prior art and the claimed invention; and (3) the level of ordinary skill in the art." *In re Mayne*, 104 F.3d 1339, 1341, 41 U.S.P.Q. 2d (BNA) 1451, 1453 (Fed. Cir. 1997) (citing *Graham v. John Deere Co.*, 383 U.S. at 17-18, 86 S.Ct. at 693-94, 148 U.S.P.Q. (BNA) 459, 466-67; *Miles Labs., Inc. v. Shandon Inc.*, 997 F.2d 870, 877, 27 U.S.P.Q. 2d (BNA) 1123, 1128 (Fed. Cir. 1993)). When present, evidence of secondary considerations "must be considered in determining obviousness." *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 667, 57 U.S.P.Q. 2d (BNA) 1161, 1169 (Fed. Cir. 2000).

Moreover, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. (BNA) 580 (C.C.P.A. 1974). "All words in a claim must be considered

in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. (BNA) 494, 496 (C.C.P.A. 1970).

Additionally, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d (BNA) 1596, 1598-99 (Fed. Cir. 1988).

1. The Examiner Relies on Non-Analogous Art for the rejection of claims 76-112.

The Examiner’s reliance on Von Kohorn and Saigh for the rejections of claims 76-112 is improper as these references are non-analogous art to Appellants’ claimed invention.

A two step test has been developed to determine whether a particular reference is within the appropriate scope of the prior art. First, it must be determined whether a particular reference is “within the field of the inventor’s endeavor.” Second, assuming the reference is outside that field, it must be determined whether the reference is “reasonably pertinent to the particular problem with which the inventor was involved.” *In re Deminski*, 796 F.2d 436, 230 U.S.P.Q. (BNA) 313, 315 (Fed. Cir. 1986).

a. The references are outside Appellants’ field of endeavor.

Von Kohorn and Saigh are outside the field of the inventor’s endeavor for at least the reasons that neither of these references relate to the relevant field of endeavor. The inventor’s field of endeavor for claims 76-112 relates to the electronic distribution of secure, trackable, money saving or discount coupons and other marketing incentives, and

in particular to use of a centrally located online computer system for interactively distributing such coupons to remotely connected consumer computers and for collecting user-specific data regarding coupon usage and user demographic information from the remote computers in part to eliminate fraud. *See* Specification, *e.g.*, pg. 1, lines 3-10; pg. 8, lines 17-25; and pg. 9, lines 11-15.

Von Kohorn clearly states that the field of the invention relates to measuring the impact of stimuli on individuals, and more particularly, to evaluating the short term and long term effectiveness of broadcast and print stimuli under varying circumstances. *See* Von Kohorn, *e.g.*, col. 1, lines 20-24.

Saigh is directed to a system for distributing information in electronic form between a central information bank and a user interface. *See* Saigh, *e.g.*, col. 1, lines 13-16.

These fields of endeavor are not within the inventor's field of endeavor. Neither are for the electronic distribution of secure, trackable, money saving or discount coupons and other marketing incentives, and in particular to use of a centrally located online computer system for interactively distributing such coupons to remotely connected consumer computers and for collecting user-specific data regarding coupon usage and user demographic information from the remote computers in an effort to eliminate fraud.

b. ***The references are not reasonably pertinent to the particular problem(s) with which Appellants were involved.***

Since Von Kohorn and Saigh are outside the inventor's field of endeavor, the inquiry becomes whether these references are reasonably pertinent to the particular problem(s) with which Appellants were involved. They are not. These problems include:

1. Providing an electronic coupon distribution system which can be easily accessed by masses of consumers by using a readily available personal computer *rather than needing to purchase special purpose equipment*. See Specification, *e.g.*, pg. 8, lines 5-9 (*emphasis added*).
2. Providing an electronic coupon distribution system which allows *a user to request transmission of coupon data* and select, store, manipulate and print coupons from such coupon data. See Specification, *e.g.*, pg. 8, lines 11-15 (*emphasis added*).
3. Providing an electronic coupon distribution system which allows the coupon issuing companies to access valuable information from the consumer without requiring specific and additional action by the consumer, but rather by using the information regarding the consumer's selection, printing and actual redemption of coupons, as well as responses to demographic queries posed to the users. See Specification, *e.g.*, pg. 8, lines 17-25.
4. Providing an electronic coupon distribution system which allows for automatic deletion of expired coupons and the modification of redemption amounts of coupons. See Specification, *e.g.*, pg. 9, lines 4-9.
5. Providing a secure coupon system which generates unique coupons with user-identifying data and limits the number of times a coupon can be printed (*e.g.*, allows the printing of a coupon only once) to deter fraud by both the consumer and the retailer. See Specification, *e.g.*, pg. 9, lines 11-15.

6. Providing an efficient, low cost, zip-code/lifestyle/lifestage or household targeted coupon distribution system to tailor the incentives to each user.

See Specification, e.g., pg. 9, lines 17-20.

A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would commend itself to an inventor's attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the inventor attempts to solve. If a reference disclosure has *the same purpose* as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it. *In re Clay*, 966 F.2d 656, 23 U.S.P.Q. 2d (BNA) 1058 (Fed. Cir. 1992). *Emphasis Added.*

Von Kohorn is more concerned with the problem of quantifying the initial impact and the continuing effectiveness of advertising on shoppers with respect to an identified advertisement in terms of the purchase of the advertised product. *See Von Kohorn, e.g., col. 1, lines 43-47.* Moreover, Von Kohorn provides special purpose equipment in the form of a custom response unit.

Saigh is more concerned with the problem of providing networks with improved dissemination of proprietary information. *See Saigh, e.g., col. 1, lines 29-50.* The Examiner relies on this reference primarily for teaching the dissemination of information over the Internet.

Neither Von Kohorn nor Saigh are reasonably pertinent to the particular problem(s) with which Appellants were involved. The Examiner cites no evidence that a person having ordinary skill in the art would reasonably have expected to solve the problem(s) of providing an electronic coupon distribution system which generates unique, secure, and

trackable coupons so as to deter fraud by considering the problem(s) of evaluating the short term and long term effectiveness of broadcast and print stimuli on individuals under varying circumstances, or providing networks with improved dissemination of proprietary information. The record is devoid of any evidence to the contrary.

As such, there would be no reason one of ordinary skill in the art would look to the diverse fields of these references absent hindsight.

Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would be reasonably motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor... [I]t is...in other words, common sense...in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor...The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q. 2d (BNA) 1443 (Fed. Cir. 1992).

For at least the foregoing reasons, Von Kohorn and Saigh are non-analogous to the invention of claims 76-112. The rejections based thereon should therefore be reversed.

2. There is no legally proper teaching, suggestion, or motivation to modify Von Kohorn to include the teachings of Saigh.

Assuming arguendo that Von Kohorn and Saigh qualify as analogous art, there is no legally proper teaching, suggestion, or motivation to modify Von Kohorn to include the teachings of Saigh, as the proposed modification would render Von Kohorn unsatisfactory for its intended purpose, and would change the principle of operation of VonKohorn.

Independent claims 76 and/or 112 recite, *inter alia*, various steps that reference an Internet-accessible location:

storing at an *Internet-accessible location* incentive information pertaining to a group of available incentives;

.....

receiving at the *Internet-accessible location*, from a user of a remote terminal, a request for access to the stored incentive information;

.....

determining at the *Internet-accessible location* if the user is a registered user....

.....

storing at the *Internet-accessible location* information regarding printed incentives

Emphasis added.

In the Final Action, at pg. 6, the Examiner concedes that Von Kohorn “*does not explicitly disclose that the communication channel can be the Internet.*” The Examiner erroneously relies on Saigh, however, for this missing element, alleging that:

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Saigh’s utilization of the Internet to Von Kohorn transmitting coupons. One would have been motivated to do this because the Internet is a readily available network for transmitting information.

This is legally improper. The Examiner’s general recitation that the Internet is a readily available way to transmit information does not adequately address why it would have been obvious to modify the particular system and method of Von Kohorn to include the Internet. For example, in a majority of the embodiments of Von Kohorn, a custom response unit is placed in systematically or randomly selected homes, used for desired research purposes, and thereupon moved to new locations. . See Von Kohorn, *e.g.*, col. 20, lines 8+. Additionally, Von Kohorn is directed to a broadcast system that sends system-initiated information. A broadcast system is a “one-to-many” communication. (*e.g.*, a transmission of television signals are broadcast to many recipients). Aspects of Appellants’ invention relate to a “one-to-one” system that enables user-specific coupons. Additionally, aspects of Appellants’ invention enable a user to initiate a request to view coupons. Thus,

in these cases, this is a user-initiated request rather than the system-initiated request of Von Kohorn.

For *at least* these reasons, there is no legally proper teaching, suggestion, or motivation to modify Von Kohorn to include the teachings of Saigh. Accordingly, the rejection is improper and should be reversed.

3. **Von Kohorn and Saigh, even when combined, fail to disclose, teach, or suggest all of the elements of claims 76-112.**

Assuming arguendo that Von Kohorn and Saigh could be combined, the combined references fail to disclose, teach, or suggest all of the elements of claims 76-112.

a. ***Independent claim 76.***

Independent claim 76 recites the claim element of **“storing at an Internet-accessible location incentive information pertaining to a group of available incentives.”** In the Final Action (at pg. 4), the Examiner alleges that the following passages of Von Kohorn disclose this claim element: (1) col. 74, lines 33-40; (2) col. 16, lines 30-40; (3) col. 19, lines 20-39; (4) FIG. 29–item 904; (5) col. 94, lines 35-41; (6) col. 95, lines 5-10; and (7) col. 45, lines 41-44. None of these cited passages, however, appear to disclose at least storing at an Internet-accessible location incentive information pertaining to a group of available incentives.

Independent claim 76 further recites the claim element of **“receiving at the Internet-accessible location, from a user of a remote terminal, a request for access to the stored incentive information.”** In the Final Action (at pg. 5), the Examiner alleges that the following passage of Von Kohorn discloses this claim element: col. 2, line 65 –

col. 3, line 2. This passage does not appear to teach that a user sends a request to an Internet-accessible location for access to stored incentive information, but rather appears to disclose that a user makes a selection on a product that has already been advertised to him or her (via broadcast) by entering a response via a response unit.

Independent claim 76 also recites the claim element of **“transmitting a prompt to the user’s remote terminal to electronically complete a user profile.”** In the Final Action (at pg. 5), the Examiner alleges that the following passages of Von Kohorn disclose this claim element: (1) col. 46, lines 41-46; and (2) col. 113, lines 20-22. Neither of these cited passages, however, appear to disclose transmitting a prompt to the user’s remote terminal to electronically complete a user profile. At best, Von Kohorn (at col. 46, lines 41-46) teaches presenting a user with a question, that if answered correctly, will earn the respondent an award. This does not, however, comprise a teaching of completing a user profile.

Independent claim 76 further recites the claim element of **“downloading to the user’s remote terminal an incentive data management software module for managing the printing of incentives.”** In the Final Action (at pg. 5), the Examiner alleges that the following passages of Von Kohorn disclose this claim element: (1) col. 2, lines 55-63; (2) col. 14, lines 20-25; (3) col. 10, lines 40-45; (4) col. 13, lines 60-66; (5) col. 74, lines 33-40; (6) col. 16, lines 35-40; and (7) FIG. 30. None of these cited passages, however, appear to disclose downloading an incentive data management software module for managing the printing of incentives.

Appellants previously raised the foregoing argument in the Amendment filed April 7, 2004, at pgs. 10-11. In the Final Action, at pgs. 16-17, the Examiner responds by providing several additional citations to various passages of Von Kohorn. The citations

relied upon by the Examiner in Von Kohorn appear to focus on the transmission of signals from the central station to remote locations (*e.g.*, Von Kohorn at col. 41, lines 28-60). Transmitting instructional or control signals, however, does not anticipate downloading to a user's remote terminal an incentive data management software module for managing the printing of incentives.

Independent claim 76 additionally recites the claim element of **“if the user is registered, the user viewing a subset of incentives from the group of available incentives, the subset of incentives being based on user-specific information, which comprises at least one of the user profile information and the user usage history information.”** In the Final Action (at pg. 5), the Examiner alleges that the following passages of Von Kohorn disclose this claim element: (1) col. 2, lines 6-37; (2) col. 3, lines 55 – col. 4, line 2; (3) col. 106, lines 1-10; and (4) col. 2, lines 49-56. None of these cited passages, however, appear to disclose enabling a registered user to view a subset of incentives from the group of available incentives.

Independent claim 76 further recites the claim element of **“printing at the remote terminal, under control of the incentive data management software module, one or more of the user-selected incentives...”** In the Final Action (at pg. 6), the Examiner alleges that the following passage of Von Kohorn discloses this claim element: col. 37, lines 10-35. This passage of Von Kohorn does not disclose printing one or more user-selected incentives under control of an incentive data management software module.

Independent claim 76 is allowable over the combination of Von Kohorn and Saigh for *at least* the reason that the addition of Saigh does not cure all of the deficiencies of Von Kohorn set forth in detail above. Accordingly, the rejection of claim 76 should be reversed. Appellants further submit that dependent claims 87- 88, 104-107 and 110-111

are allowable because they depend from allowable independent claim 76, as well as for the further limitations they contain.

b. *Dependent claims 77-86, 89-103, and 108-109.*

Appellants submit that dependent claims 77-86, 89-103, and 108-109 are allowable because they depend from allowable independent claim 76, as well as for the further limitations they contain, as described below.

Claim 77

Claim 77 further recites the claim element of “wherein storing at an Internet-accessible location incentive information pertaining to a group of available incentives further comprises storing advertising materials provided by one or more incentive issuers or distributors.” The passage relied upon by the Examiner in Von Kohorn (for claim 77) does not appear to disclose the element(s) of claim 77. For at least this reason, the rejection of claim 77 is improper and should be reversed.

Claim 78

Claim 78 further recites the claim element of “wherein the advertising materials comprise one or more of graphics, text, recipes, competitions, or inducements.” The passage relied upon by the Examiner in Von Kohorn (for claim 78) does not appear to disclose the element(s) of claim 78. For at least this reason, the rejection of claim 78 is improper and should be reversed.

Claim 79

Claim 79 further recites the claim element of “wherein enabling a user to view a subset of incentives further comprises the step of enabling the user to view the advertising materials.” The passages relied upon by the Examiner in Von Kohorn (for claim 79) do not appear to disclose the element(s) of claim 79. For at least this reason, the rejection of claim 79 is improper and should be reversed.

Claim 80

Claim 80 further recites the claim element of “wherein the user profile received and stored at the Internet-accessible location comprises demographic data.” The passages relied upon by the Examiner in Von Kohorn (for claim 80) do not appear to disclose the element(s) of claim 80. For at least this reason, the rejection of claim 80 is improper and should be reversed.

Claim 81

Claim 81 further recites the claim element of “wherein redemption data for multiple users is used by the at least one incentive distributor or incentive issuer for market analysis to compile at least one subsequent incentive targeted specifically at the user.” The passages relied upon by the Examiner in Von Kohorn (for claim 81) do not appear to disclose the element(s) of claim 81. For at least this reason, the rejection of claim 81 is improper and should be reversed.

Claim 82

Claim 82 further recites the claim element of “wherein the at least one subsequent incentive is provided to the user via an electronic mail message.” The passage relied upon

by the Examiner in Saigh (for claim 82) does not appear to disclose the element(s) of claim 82. Moreover, for the reasons set forth in detail above, there is no legally proper motivation to combine Von Kohorn and Saigh. For at least this reason, the rejection of claim 82 is improper and should be reversed.

Claim 83

Claim 83 further recites the claim element of “wherein the at least one subsequent incentive is downloaded from the Internet-accessible location.” The passages relied upon by the Examiner in Von Kohorn and Saigh (for claim 83) do not appear to disclose the element(s) of claim 83. Moreover, for the reasons set forth in detail above, there is no legally proper motivation to combine Von Kohorn and Saigh. For at least this reason, the rejection of claim 83 is improper and should be reversed.

Claim 84

Claim 84 further recites the claim element of “wherein the at least one subsequent incentive is for a product other than a product covered by the one or more redeemed printed incentives.” The passages relied upon by the Examiner in Von Kohorn (for claim 84) do not appear to disclose the element(s) of claim 84. For at least this reason, the rejection of claim 84 is improper and should be reversed.

Claim 85

Claim 85 further recites the claim element of “wherein the at least one subsequent incentive is for a same product covered by the one or more redeemed printed incentives, but having a different value.” The passages relied upon by the Examiner in Von Kohorn

(for claim 85) do not appear to disclose the element(s) of claim 85. For at least this reason, the rejection of claim 85 is improper and should be reversed.

Claim 86

Claim 86 further recites the claim element of “wherein the at least one subsequent incentive is transmitted to a retailer for electronic redemption.” The passages relied upon by the Examiner in Von Kohorn (for claim 86) do not appear to disclose the element(s) of claim 86. For at least this reason, the rejection of claim 86 is improper and should be reversed.

Claim 89

Claim 89 further recites the claim element of “wherein the incentives available to a user are sorted by categories.” The passage relied upon by the Examiner in Von Kohorn (for claim 89) does not appear to disclose the element(s) of claim 89. For at least this reason, the rejection of claim 89 is improper and should be reversed.

Claim 90

Claim 90 further recites the claim element of “downloading to the remote terminal a unique identifier.” The passage relied upon by the Examiner in Von Kohorn (for claim 90) does not appear to disclose the element(s) of claim 90. For at least this reason, the rejection of claim 90 is improper and should be reversed.

Claim 91

Claim 91 further recites the claim element of “wherein downloading the incentive data management software module comprises downloading the unique identifier.” The passages relied upon by the Examiner in Von Kohorn (for claim 91) do not appear to disclose the element(s) of claim 91. Von Kohorn discloses neither a software download nor a unique identifier (e.g., a unique number stored on the user’s computer). For at least this reason, the rejection of claim 91 is improper and should be reversed.

Claim 92

Claim 92 further recites the claim element of “wherein the unique identifier is stored on the remote terminal.” The passages relied upon by the Examiner in Von Kohorn (for claim 92) do not appear to disclose the element(s) of claim 92. For at least this reason, the rejection of claim 92 is improper and should be reversed.

Claim 93

Claim 93 further recites the claim element of “wherein the unique identifier is included on a printed incentive.” The passages relied upon by the Examiner in Von Kohorn (for claim 93) do not appear to disclose the element(s) of claim 93. For at least this reason, the rejection of claim 93 is improper and should be reversed.

Claim 94

Claim 94 further recites the claim element of “wherein a printed incentive includes a bar code printed thereon, the bar code including the unique identifier.” The passages relied upon by the Examiner in Von Kohorn (for claim 94) do not appear to disclose the

element(s) of claim 94. For at least this reason, the rejection of claim 94 is improper and should be reversed.

Claim 95

Claim 95 further recites the claim element of “wherein each printed incentive is unique.” The passages relied upon by the Examiner in Von Kohorn (for claim 95) do not appear to disclose the element(s) of claim 95. For at least this reason, the rejection of claim 95 is improper and should be reversed.

Claim 96

Claim 96 further recites the claim element of “wherein each printed incentive is printed with a unique bar code.” The passages relied upon by the Examiner in Von Kohorn (for claim 96) do not appear to disclose the element(s) of claim 96. For at least this reason, the rejection of claim 96 is improper and should be reversed.

Claim 97

Claim 97 further recites the claim element of “wherein each printed incentive is printed with a unique bar code including unique identification information.” The passages relied upon by the Examiner in Von Kohorn (for claim 97) do not appear to disclose the element(s) of claim 97. For at least this reason, the rejection of claim 97 is improper and should be reversed.

Claim 98

Claim 98 further recites the claim element of “wherein the printing of an incentive includes printing an incentive with a unique information number.” The passages relied upon by the Examiner in Von Kohorn (for claim 98) do not appear to disclose the element(s) of claim 98. For at least this reason, the rejection of claim 98 is improper and should be reversed.

Claim 99

Claim 99 further recites the claim element of “wherein the user profile includes demographic data.” The passages relied upon by the Examiner in Von Kohorn (for claim 99) do not appear to disclose the element(s) of claim 99. For at least this reason, the rejection of claim 99 is improper and should be reversed.

Claim 100

Claim 100 further recites the claim element of “wherein the demographic data comprises zip code information.” The passages relied upon by the Examiner in Von Kohorn (for claim 100) do not appear to disclose the element(s) of claim 100. For at least this reason, the rejection of claim 100 is improper and should be reversed.

Claim 101

Claim 101 further recites the claim element of “wherein the demographic data comprises geographic information.” The passages relied upon by the Examiner in Von Kohorn (for claim 101) do not appear to disclose the element(s) of claim 101. For at least this reason, the rejection of claim 101 is improper and should be reversed.

Claim 102

Claim 102 further recites the claim element of “wherein the user profile includes at least information that can be used to subsequently target specific incentives for a user. ” The passages relied upon by the Examiner in Von Kohorn (for claim 102) do not appear to disclose the element(s) of claim 102. For at least this reason, the rejection of claim 102 is improper and should be reversed.

Claim 103

Claim 103 further recites the claim element of “wherein the user profile includes user preference information.” The passages relied upon by the Examiner in Von Kohorn (for claim 103) do not appear to disclose the element(s) of claim 103. For at least this reason, the rejection of claim 103 is improper and should be reversed.

Claim 108

Claim 108 further recites the claim element of “wherein the redemption information is associated with the remote terminal.” The passages relied upon by the Examiner in Von Kohorn (for claim 108) do not appear to disclose the element(s) of claim 108. For at least this reason, the rejection of claim 108 is improper and should be reversed.

Claim 109

Claim 109 further recites the claim element of “wherein the redemption information is associated with a user associated with the remote terminal.” The passages

relied upon by the Examiner in Von Kohorn (for claim 109) do not appear to disclose the element(s) of claim 109. For at least this reason, the rejection of claim 109 is improper and should be reversed.

c. *Independent claim 112.*

Independent claim 112 recites the claim element of “**storing at an Internet-accessible location incentive information pertaining to a group of available incentives.**” In the Final Action (at pg. 4), the Examiner alleges that the following passages of Von Kohorn disclose this claim element: (1) col. 74, lines 33-40; (2) col. 16, lines 30-40; (3) col. 19, lines 20-39; (4) FIG. 29—item 904; (5) col. 94, lines 35-41; (6) col. 95, lines 5-10; and (7) col. 45, lines 41-44. None of these cited passages, however, appear to disclose at least storing at an Internet-accessible location incentive information pertaining to a group of available incentives.

Independent claim 112 further recites the claim element of “**receiving at the Internet-accessible location, from a user of a remote terminal, a request for access to the stored incentive information.**” In the Final Action (at pg. 5), the Examiner alleges that the following passage of Von Kohorn discloses this claim element: col. 2, line 65 – col. 3, line 2. This passage does not appear to teach that a user sends a request to an Internet-accessible location for access to stored incentive information, but rather appears to disclose that a user makes a selection on a product that has already been advertised to him or her (via broadcast) by entering a response via a response unit.

Independent claim 112 additionally recites the claim element of “**transmitting a prompt to the user’s remote terminal to electronically complete a user profile.**” In the Final Action (at pg. 5), the Examiner alleges that the following passages of Von Kohorn

disclose this claim element: (1) col. 46, lines 41-46; and (2) col. 113, lines 20-22. Neither of these cited passages, however, appear to disclose transmitting a prompt to the user's remote terminal to electronically complete a user profile. At best, Von Kohorn (at col. 46, lines 41-46) teaches presenting a user with a question, that if answered correctly, will earn the respondent an award. This does not, however, comprise a teaching of completing a user profile.

Independent claim 112 recites the claim element of **“downloading to the user's remote terminal an incentive data management software module for managing the printing of incentives.”** In the Final Action (at pg. 5), the Examiner alleges that the following passages of Von Kohorn disclose this claim element: (1) col. 2, lines 55-63; (2) col. 14, lines 20-25; (3) col. 10, lines 40-45; (4) col. 13, lines 60-66; (5) col. 74, lines 33-40; (6) col. 16, lines 35-40; and (7) FIG. 30. None of these cited passages, however, appear to disclose downloading an incentive data management software module for managing the printing of incentives.

Appellants previously raised the foregoing argument in the Amendment filed April 7, 2004, at pgs. 10-11. In the Final Action, at pgs. 16-17, the Examiner responds by providing several additional citations to various passages of Von Kohorn. The citations relied upon by the Examiner in Von Kohorn appear to focus on the transmission of signals from the central station to remote locations (*e.g.*, Von Kohorn at col. 41, lines 28-60). Transmitting instructional or control signals, however, does not anticipate downloading to a user's remote terminal an incentive data management software module for managing the printing of incentives.

Independent claim 112 further recites the claim element of **“if the user is registered, the user viewing a subset of incentives from the group of available**

incentives.” In the Final Action (at pg. 5), the Examiner alleges that the following passages of Von Kohorn disclose this claim element: (1) col. 2, lines 6-37; (2) col. 3, lines 55 – col. 4, line 2; (3) col. 106, lines 1-10; and (4) col. 2, lines 49-56. None of these cited passages, however, appear to disclose enabling a registered user to view a subset of incentives from the group of available incentives.

Independent claim 112 additionally recites the claim element of “**printing at the remote terminal, under control of the incentive data management software module, one or more of the user-selected incentives...**” In the Final Action (at pg. 6), the Examiner alleges that the following passage of Von Kohorn discloses this claim element: col. 37, lines 10-35. This passage of Von Kohorn does not disclose printing one or more user-selected incentives under control of an incentive data management software module.

Independent claim 112 is allowable over the combination of Von Kohorn and Saigh for *at least* the reason that the addition of Saigh does not cure all of the deficiencies of Von Kohorn set forth in detail above. Accordingly, the rejection of claim 112 should be reversed.

VIII. CLAIMS APPENDIX - 37 C.F.R. §41.37(c)(1)(viii)

The pending claims (claims 76-112) are attached in the Appendix.


CONCLUSION

For at least the foregoing reasons, Appellants respectfully request that the rejections of each of pending claims 76-112 be reversed.

Date: **March 10, 2005**

Respectfully submitted,

By:


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CLAIMS APPENDIX

Claims 1-75. *cancelled*

76. *(Previously Presented)* A method for viewing and printing at a remote terminal user-specific incentives, the method comprising:

storing at an Internet-accessible location incentive information pertaining to a group of available incentives;

storing user profile information and user usage history information for one or more users;

receiving at the Internet-accessible location, from a user of a remote terminal, a request for access to the stored incentive information;

determining at the Internet-accessible location if the user is a registered user, and if the user is not registered:

- i) transmitting a prompt to the user's remote terminal to electronically complete a user profile;
- ii) receiving and storing the user profile; and
- iii) downloading to the user's remote terminal an incentive data management software module for managing the printing of incentives, wherein a printed incentive includes unique user identification information;

if the user is registered, the user viewing a subset of incentives from the group of available incentives, the subset of incentives being based on user-specific information, which comprises at least one of the user profile information and the user usage history information;

the user selecting one or more incentives from the subset of incentives for printing, each of the one or more incentives comprising various fields, including a redemption amount field and at least one other field, the redemption amount field comprising data indicative of a discount provided by the incentive, the at least one other field being determined in accordance with user-specific information associated with the requesting user;

printing at the remote terminal, under control of the incentive data management software module, one or more of the user-selected incentives which can be redeemed by a user;

storing at the Internet-accessible location information regarding printed incentives;
subsequent to a user redeeming one or more of the printed incentives, storing
redemption information;

providing at least incentive redemption data to at least one incentive distributor or
incentive issuer to enable the at least one incentive distributor or incentive issuer to use at
least the incentive redemption data for market analysis to create at least one subsequent
targeted incentive targeted based on targeting criteria; and

making the at least one subsequent incentive available to a user if the user satisfies the
targeting criteria.

77. ***(Previously Presented)*** The method of claim 76, wherein storing at an Internet-
accessible location incentive information pertaining to a group of available incentives further
comprises storing advertising materials provided by one or more incentive issuers or
distributors.

78. ***(Previously Presented)*** The method of claim 77, wherein the advertising materials
comprise one or more of graphics, text, recipes, competitions, or inducements.

79. ***(Previously Presented)*** The method of claim 77, wherein enabling a user to view a
subset of incentives further comprises the step of enabling the user to view the advertising
materials.

80. ***(Previously Presented)*** The method of claim 76, wherein the user profile received and
stored at the Internet-accessible location comprises demographic data.

81. ***(Previously Presented)*** The method of claim 76, wherein redemption data for multiple
users is used by the at least one incentive distributor or incentive issuer for market analysis to
compile at least one subsequent incentive targeted specifically at the user.

82. ***(Previously Presented)*** The method of claim 76, wherein the at least one subsequent
incentive is provided to the user via an electronic mail message.

83. *(Previously Presented)* The method of claim 76, wherein the at least one subsequent incentive is downloaded from the Internet-accessible location.

84. *(Previously Presented)* The method of claim 76, wherein the at least one subsequent incentive is for a product other than a product covered by the one or more redeemed printed incentives.

85. *(Previously Presented)* The method of claim 76, wherein the at least one subsequent incentive is for a same product covered by the one or more redeemed printed incentives, but having a different value.

86. *(Previously Presented)* The method of claim 76, wherein the at least one subsequent incentive is transmitted to a retailer for electronic redemption.

87. *(Previously Presented)* The method of claim 76, wherein the Internet-accessible location is associated with an online service provider.

88. *(Previously Presented)* The method of claim 76, wherein the Internet-accessible location is associated with an Internet web site.

89. *(Previously Presented)* The method of claim 76, wherein the incentives available to a user are sorted by categories.

90. *(Previously Presented)* The method of claim 76, further comprising downloading to the remote terminal a unique identifier.

91. *(Previously Presented)* The method of claim 90, wherein downloading the incentive data management software module comprises downloading the unique identifier.

92. *(Previously Presented)* The method of claim 90, wherein the unique identifier is stored on the remote terminal.

93. ***(Previously Presented)*** The method of claim 90, wherein the unique identifier is included on a printed incentive.
94. ***(Previously Presented)*** The method of claim 90, wherein a printed incentive includes a bar code printed thereon, the bar code including the unique identifier.
95. ***(Previously Presented)*** The method of claim 76, wherein each printed incentive is unique.
96. ***(Previously Presented)*** The method of claim 76, wherein each printed incentive is printed with a unique bar code.
97. ***(Previously Presented)*** The method of claim 76, wherein each printed incentive is printed with a unique bar code including unique identification information.
98. ***(Previously Presented)*** The method of claim 76, wherein the printing of an incentive includes printing an incentive with a unique information number.
99. ***(Previously Presented)*** The method of claim 76, wherein the user profile includes demographic data.
100. ***(Previously Presented)*** The method of claim 99, wherein the demographic data comprises zip code information.
101. ***(Previously Presented)*** The method of claim 99, wherein the demographic data comprises geographic information.
102. ***(Previously Presented)*** The method of claim 76, wherein the user profile includes at least information that can be used to subsequently target specific incentives for a user.
103. ***(Previously Presented)*** The method of claim 76, wherein the user profile includes user preference information.

104. ***(Previously Presented)*** The method of claim 76, wherein registering associates the user with an account.
105. ***(Previously Presented)*** The method of claim 104, wherein a household of users may be linked through the account.
106. ***(Previously Presented)*** The method of claim 76, wherein a household of users may be linked through one account.
107. ***(Previously Presented)*** The method of claim 76, wherein a user may be an individual user or a household of users.
108. ***(Previously Presented)*** The method of claim 76, wherein the redemption information is associated with the remote terminal.
109. ***(Previously Presented)*** The method of claim 76, wherein the redemption information is associated with a user associated with the remote terminal.
110. ***(Previously Presented)*** The method of claim 76, wherein the redemption information is associated with an account associated with the remote terminal.
111. ***(Previously Presented)*** The method of claim 76, wherein incentives are printed using the incentive data management software module which is invoked when a user selects a print command.

112. *(Previously Presented)* A method for viewing and printing at a remote terminal user-specific incentives, the method comprising:

storing at an Internet-accessible location incentive information pertaining to a group of available incentives;

receiving at the Internet-accessible location, from a user of a remote terminal, a request for access to the stored incentive information;

determining at the Internet-accessible location if the user is a registered user, and if the user is not registered:

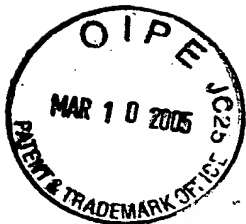
- i) transmitting a prompt to the user's remote terminal to electronically complete a user profile;
- ii) receiving and storing the user profile; and
- iii) downloading to the user's remote terminal incentive data management software for managing the printing of incentives;

if the user is registered, the user viewing a subset of incentives from the group of available incentives, the subset of incentives being based on user-specific information;

the user selecting one or more incentives from the subset of incentives for printing; printing at the remote terminal, under control of the incentive data management software, one or more of the user-selected incentives which can be redeemed by a user.



EXHIBIT A



IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MARYLAND
SOUTHERN DIVISION

BLACK DIAMOND CCT HOLDINGS,
LLC, *et al.*,
Plaintiffs,

v.

COUPONS, INC.,
Defendant.

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CIVIL ACTION NO. RDB-02-3701

* * * * *

MEMORANDUM AND ORDER
RE: PATENT CLAIM CONSTRUCTION

In this case, Plaintiffs Black Diamond CCT Holdings, LLC and E-Centives, Inc. (collectively, “Plaintiffs”) sue Defendant Coupons, Inc. (“Coupons”) for infringement of the claims of United States Patent Nos. 6,336,099 (the “’099 Patent”) and 6,321,208 (the “’208 Patent”) (collectively, the “Patents”).¹ Pursuant to the Scheduling Order, the parties have filed materials relating to what they have specified as material claim construction issues. The Court held a claim construction hearing on Monday, November 10, 2003 for purposes of reviewing the intrinsic evidence of record.

I. GENERAL PRINCIPLES OF CLAIM CONSTRUCTION

The construction of patent claims is a matter for the court. Markman v. Westview Instruments, Inc., 517 U.S. 370, 390 (1996). When constructing a term in a patent claim, “the focus is on the objective test of what one of ordinary skill in the art at the time of the invention would have understood

¹The ‘099 Patent is a continuation of the ‘208 Patent. The specifications of both Patents are nearly identical. The ‘208 Patent is directed toward a method of electronic coupon distribution, while the ‘099 Patent is directed toward a system of electronic coupon distribution.

the term to mean.” Markman v. Westview Instruments, Inc., 52 F.3d 967, 986 (Fed. Cir. 1995) (en banc), affd, 517 U.S. 370 (1996).

The Court must first look at the basic evidence of record, namely, the language of the claim, the specification, and the prosecution history. Insituform Tech., Inc. v. Cat Contracting, Inc., 99 F.3d 1098, 1105 (Fed. Cir. 1996), cert. denied, 520 U.S. 1198 (1997). The claim language itself defines the scope of the claim. Therefore, “a construing court does not accord the specification, prosecution history, and other relevant evidence the same weight as the claims themselves, but consults these sources to give the necessary context to the claim language.” Eastman Kodak Co. v. Goodyear Tire & Rubber Co., 114 F.3d 1547, 1552 (Fed. Cir. 1997).

The Court of Appeals for the Federal Circuit has held that claims should be read in view of the specification. See, e.g., id. at 1582. However, the Federal Circuit cautions against limiting the scope of a claim to the preferred embodiment or to specific examples disclosed in the specification. See, e.g., Ekchian v. Home Depot, Inc., 104 F.3d 1299, 1303 (Fed. Cir. 1997); see also Intervet Am., Inc. v. Kee-Vet Lab., Inc., 887 F.2d 1050, 1053 (Fed. Cir. 1989) (“[L]imitations appearing in the specification will not be read into claims, and . . . interpreting what is meant by a word in a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’”) (citation omitted).

II. DISCUSSION

A. The Patents and Claims at Issue

In broad terms, the Patents describe an Internet-based, print-at-home, secure couponing service, which generates customized and targeted discount coupons and other marketing incentives in

response to information provided by individual users or groups of users, and which enables the detection and prevention of fraud. Plaintiffs assert infringement of Claims 1-7 of the '208 Patent and Claims 1-8, 10-22, 24-35, and 37-40 of the '099 Patent. The parties seek the Court's construction of the terms that are highlighted below:

1. The '208 Patent:

Independent Claim 1 of the '208 Patent contains the following disputed terms:

An online method for a user to view and print at a remote terminal user-specific coupons based on a user profile, the method comprising the steps of:

- (a) storing in a storage device at a central location electronic coupon information pertaining to a group of coupons available;
- (b) receiving a request from a user for access to stored coupon information;
- (c) determining if the user is a registered user, and if the user is not registered:
 - (i) transmitting a prompt to the remote terminal to electronically complete a user profile and transmit the user profile to the central location;
 - (ii) receiving and storing a user profile at the central location; and
 - (iii) downloading to the remote terminal a coupon data management software module for managing the printing of coupons, including unique user identification information;
- if the user is registered, accessing the stored user profile;
- (d) viewing, by a remote terminal, selected ones of the stored coupons, the selected coupons being based on user-specific information, which comprises user profile information and/or user usage history information;
- (e) receiving at the central location a request to transmit to the remote terminal at least one coupon data file, the coupon data file corresponding to a user selected coupon, the coupon data file comprising various fields, including a redemption amount field and other fields, the redemption amount field being indicative of a discount provided by the

coupon, the redemption amount field and at least one other field being variable in accordance with user-specific information associated with the requesting user; and

- (f) transmitting to the remote terminal the at least one coupon data file to enable the user to print a coupon using the coupon data management software module.

'208 Patent, col. 14, ll. 8-47. The disputed terms in the dependent claims of the '208 Patent also appear in independent Claim 1 and therefore will be interpreted to have the same meanings as they have in the independent claim.

2. The '099 Patent:

The '099 Patent contains two independent claims, Claims 1 and 21, which are substantially identical except for the final paragraph. Claim 1 states:

A central, computer-based system for providing remote users with access via remote terminals to user-specific incentives based at least in part on user-specific information over an online network, the central system comprising:

a central data repository having memory in which is stored incentive offer data and remote user data;

at least one server operatively associated with the central data repository for accessing and storing incentive offer and remote user data;

at least one communication device in operative association with the server, whereby the central system establishes an electrical communication with a remote terminal operated by a remote user, whereby the central system obtains remote user data, including user-specific information; and

a graphical user interface in association with the server and the remote terminal for presenting to the remote user at the remote terminal one or more retailers and one or more incentive offers associated with the user selected retailer, the remote terminal communicating the user selection to the central system, the central system generating a user-specific incentive associated with each selected offer for redemption by the remote user.

'099 Patent, col. 14, ll. 14-40; see also '208 Patent, col. 15, l. 54 - col. 16, l. 2. The final paragraph of Claim 21 differs in its language and provides:

a graphical user interface in association with the server and the remote terminal for presenting to the remote user at the remote terminal one or more categories of goods or services and one or more incentive offers associated with the goods or services for user selection, the presentation being based at least in part on the user-specific information, whereby the user selects a good or service and one or more incentive offers associated with the user selected good or service, the remote terminal communicating the user selection to the central system generating a user-specific incentive concerning each user selected offer for redemption by the remote user.

'099 Patent, col. 16, ll. 3-14. Certain of the disputed terms in the dependent claims of the '099 Patent also appear in independent Claims 1 and 21 and will be interpreted to have the same meanings as they have in the independent claim. The terms "other fields" and "various fields" in dependent Claims 2 and 28 are disputed and do not appear in the independent claims. Claim 2 states:

The system of Claim 1, wherein the user-specific incentive generated by the central system is transmitted to the remote terminal and includes at least one incentive data file, the incentive data file corresponding to the user selected offer, the incentive data file comprising **various fields**, including a redemption amount field, and **other fields**, the redemption amount field being indicative of a discount provided by the selected offer, at least one field being variable in accordance with user-specific information associated with the requesting user.

Id., col. 14, ll. 41-50. Claim 28 is substantially the same as Claim 2, except it depends on Claim 21 instead of Claim 1. See id., col. 16, ll. 30-38. Accordingly, the terms will be construed as having the same meaning in both dependent claims.

Finally, Claims 5 and 31 are disputed in their entirety. Claim 5 states: **"The system of Claim 1, wherein the user-specific information includes a zip code, city, state, user address, user name, or user telephone number."** Id., col. 14, ll. 65-67. Claim 31 is substantially the same as

Claim 5, except it depends on Claim 21 instead of Claim 1. See id., col. 16, ll. 51-53. These terms will be construed as having the same meaning in both dependent claims.

B. Construction of the Claim Language

1. User

“Although words in a claim are generally given their ordinary and customary meaning, a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history.” Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996) (citing Hoechst Celanese Corp. v. BP Chems. Ltd., 78 F.3d 1575, 1578 (Fed. Cir. 1996)). Plaintiffs define the term “user” by reference to the ‘208 Patent specification as “an individual or household of users.” See ‘208 Patent, col. 6, ll. 50-51 (“[a]s used herein, the term ‘user’ denotes an individual user or a household of users linked through one account.”). Ordinarily, the specification is dispositive as to the meaning of a disputed term when it expressly defines terms used in the claims. Vitronics Corp., 90 F.3d at 1582. However, in this case, the specification contains alternate definitions for the term “user,” one of which is not supported or enabled by the specification. For instance, the specification contains no provision for the establishment of an “account” for purposes of utilizing the electronic coupon distribution service. The specification also does not define what combination of individuals may constitute a “household” for purposes of utilizing the system and does not identify how members of a “household” may be linked through a single account.

Coupons asserts that the specification and prosecution history teach that the system works only if the “user” is an individual. It cites portions of the specification that discuss the printing of a user-

specific bar code on each coupon to prevent duplication and multiple redemption. See '208 Patent, col. 5, ll. 49-62. "The user bar code is encoded with user-specific information such as the name and/or other unique identification criteria such as a social security number or online service address. This information renders each printed coupon 18 unique, since an otherwise similar coupon presented by a different consumer will comprise a different user bar code 90." Id., col. 7, ll. 21-34.

Coupons also cites portions of the June 12, 1997 Amendment for the proposition that the '208 Patent distinguishes itself from the DeLapa Patent, which encodes each coupon with a machine-readable code that identifies the household of the consumer. 6/12/97 Amdt. at 15-16. However, DeLapa is distinguishable from the present invention not because of the information encoded on each coupon, but rather because of the method by which unique coupons are assembled. Whereas the coupons referenced in DeLapa are printed at a central site and then sent to the user in hard copy, the coupons generated by the instant invention are printed from the user's own computer using data stored on that computer and data obtained from the coupon repository. Therefore, Coupons' reliance on the June 12, 1997 Amendment seems misplaced.

In the April 30, 1998 Amendment, however, the patentee notes that each coupon is personalized with user-specific data pertinent only to an individual and not multiple individuals, such as the user's name or social security number. 4/30/98 Amdt. at 10-11. The purpose of including such information is to facilitate detection of duplicative redemptions and to allow manufacturers to track and analyze who has requested coupons and who has actually used them. Id.

The specification notes that the coupon distribution center utilizes the user-specific redemption data along with user-specific demographic data supplied by the online service provider in order to

compile subsequent coupon data download packages for use by consumers. '208 Patent, col. 7, ll. 51-55. By way of example, the specification states that "it may be determined by the analysis means that users with dogs in their household (which is known by the demographic responses) will get a certain package comprising dog food coupons." Id., col. 12, ll. 41-44. A user's selection, printing, and redemption of certain coupons will trigger a further customized response from the system. See id. Because the demographic information provided by each user is broad enough to encompass the preferences of members of the user's household (thus facilitating targeted marketing of households), it would be inconsistent to define the term "user" as multiple members of the same household. Plaintiffs' definition of the term to include members of a household linked through one account is rejected as overbroad and unsupported by the specification or patent history. See Genentech, Inc. v. Wellcome Foundation Ltd., 29 F.3d 1555, 1564 (Fed. Cir. 1994). Accordingly, the term "user" shall be construed to mean an individual who utilizes the electronic coupon distribution service to request and obtain coupons or incentives.

2. Remote User

The term "remote user" appears in independent Claims 1 and 21 and several dependent claims of the '099 Patent and is not defined in the specification. Therefore, the Court will construe the term in accordance with its plain and ordinary meaning. Quantum Corp. v. Rodime, PLC, 65 F.3d 1577, 1580 (Fed. Cir. 1995) ("[T]he words of a claim will be given their ordinary meaning to one of skill in the art unless the inventor appeared to use them differently."). Claim 1 of the '099 Patent supports such a construction. See '099 Patent, col. 14, ll. 15-16 and 25-26 ("a central, computer based system for providing remote users with access via remote terminals"). The specification's definition of a remote

user computer or remote terminal provides further support. See '099 Patent, col. 4, ll. 50-54 ("The remote user computer in the present invention comprises interface means for providing user interaction with the centrally located repository, a memory, and a coupon data management program."). Accordingly, the term "remote user" shall be construed as a user who accesses the system using a remote terminal or a remote user computer.

3. Remote User Data

“Remote user data” appears in Claims 1 and 21 of the ‘099 Patent and dependent Claim 19 and is not defined in the specification. Plaintiffs’ definition of the term as “data pertaining to a remote user” is overbroad. See SRI Int’l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc) (claim language defines claim scope). The claims expressly limit the definition to data that is obtained by and stored at the central repository and which includes user-specific information (as defined below) and “prior selection and redemption data associated with the remote user.”

4. Registered User

The term “registered user,” as used in Claim 1(c) of the ‘208 Patent, must be construed in accordance with its plain and ordinary meaning to a person skilled in the art. Plaintiffs’ proposed construction is supported by reference to the American Heritage College Dictionary (3d ed. 1993), which defines “register” as “[t]o enroll officially or formally . . .” or “to place one’s name in a register.” In addition, the specification describes the process of initial registration for the electronic coupon distribution service as follows:

An online display screen 60 is shown in FIG. 4a, which is provided to a user on a display 24 of his remote computer 6 whenever he is in online communication with the service provider 2. The online display screen 60 comprises a join service function button 62, a download coupons function button 64, a help function button 66, and an online communications button 68. When the user desires to initially register for the electronic coupon distribution service, he selects the join service function button 62 which initiates a dialog with the online service provider 2 in order to request certain demographic data from the user which will be used to target specific coupon data packages for subsequent downloading. The user has the option of providing the requested information if he so desires. In addition, an offline coupon management program is transmitted electronically to the user’s computer 6 for subsequent coupon data requesting, downloading and processing.

'208 Patent, col. 7, l. 56-col. 8, l. 5. Therefore, the Court construes the term "registered user" to mean a user who has become eligible to utilize the electronic coupon distribution service by joining the service and thus registering with the system.

5. User Profile

The term "user profile" appears in Claim 1(c)(i) of the '208 Patent. If the user is not a registered user, the system will "transmit[] a prompt to the remote terminal to electronically complete a user profile and transmit the user profile to the central location." '208 Patent, col. 14, ll. 19-20. Claim 1(c)(ii) states that the user profile will be received and stored at the central location. Id., col. 14, ll. 22-23. The term subsequently appears in dependent Claim 6: "The method of claim 1 wherein the user profile comprises demographic data associated with the user." Id., col. 14, ll. 56-57.

The term does not appear in the specification. The specification contains numerous references to a demographic data file, which contains demographic data obtained from the user at the time of initial registration, data representative of responses to demographic inquiries presented to the user at the time the user requests a download of coupon data, and a record indicative of each coupon selected by the user and printed by the user. See '208 Patent, col. 5, ll. 6-12; col. 6, ll. 58-62; col. 7, ll. 62-col. 8, l. 1; col. 8, ll. 34-38; col. 9, ll. 46-53; col. 10, ll. 51-57. However, it is unclear from the specification how much of the information contained in the demographic data file comprises the user profile. Accordingly, in the absence of guidance from the specification, the Court construes the term "user profile" in a manner consistent with the claims to mean a summary of demographic data provided by the user in response to requests during the initial registration process.

6. User Profile Information

Claim 1(d) of the '208 Patent identifies "user profile information" as a subset of "user-specific information." '208 Patent, col. 14, ll. 30-34 ("the selected coupons being based on user-specific information, which comprises user profile information and/or user usage history information."). The specification is silent as to the definition of the term. The Court construes the term to mean information in the user profile.

7. Unique User Identification Information

The term "unique user identification information" appears in Claim 1(c)(iii) of the '208 Patent in the following context: "downloading to the remote terminal a coupon data management software module for managing the printing of coupons, including unique user identification information . . ." '208 Patent, col. 14, ll. 24-27. The specification notes that coupons are printed by the coupon data generation routine, which relies on fixed coupon data transmitted to the user's computer during the registration process and variable coupon data that is transmitted to the user's computer whenever he requests coupon data from the central repository. *Id.*, col. 5, ll. 6-13. In the preferred embodiment, the fixed data includes a user identification bar code number, which is a unique number assigned to the user, for example his social security number or online identification number. *Id.*, col. 11, ll. 2-4. The number is encoded by the printable coupon data generation routine and is printed as a bar code on each coupon printed for the particular user. *Id.*, col. 11, ll. 4-7. One purpose of the user identification bar code is to render printed coupons unique as between users, and thus to prevent duplication and multiple redemption of the same coupon. Reading the disputed term in the context of the specification,

the Court construes the term “unique user identification information” to mean information that is stored on the user’s remote terminal that uniquely identifies the user.

8. User Usage History Information

The term “user usage history” appears in Claim 1(d) of the ‘208 Patent and, like the term “user profile information,” is described as a subset of “user-specific information.” See ‘208 Patent, col. 14, ll. 30-34. The specification makes clear that the coupon distributor collects information regarding the coupon data selected by the user, the coupon data printed by the user, and demographic information relating to the user. *Id.*, col. 12, ll. 28-33. The coupon distributor also collects and stores information from the coupon redemption center about the coupons actually redeemed. *Id.*, col. 12, ll. 33-35. That information is analyzed, and, based on marketing and targeting criteria and objectives, different coupon packages are generated and transmitted to the online service provider. *Id.*, col. 12, ll. 53-55. Accordingly, the Court construes “user usage history” to mean data relating to a user’s selection, printing and redemption of coupons over time.

9. User-specific Information

The term “user-specific information” appears primarily in Claims 1(d) and 1(e) of the ‘208 Patent and in Claims 1 and 21 of the ‘099 Patent. According to Claim 1(d) of the ‘208 Patent, user-specific information may include user profile information and user usage history information. Claim 1 of the ‘099 Patent describes user-specific information as a subset of remote user data that is transmitted to the central system. The specification indicates that user-specific information, which may include the user’s name, social security number, or online service address, is encoded in each coupon “in the form

of a unique user bar code 90” and “renders each printed coupon unique.” See ‘099 Patent, col. 7, ll 26-32. The Court adopts Plaintiffs’ proposed definition of the term, “information specific to a user.”

10. Central Data Repository

Defendant accepts Plaintiffs' proposed construction of the term "central data repository" in Claims 1 and 21 of the '099 Patent as any centrally located computer system that stores electronic coupon information (including incentive offer data and product redemption coupon data) and remote user data, said computer system comprising one or more computers or Internet sites. The proposed construction is supported by the claims and specifications. See '099 Patent, col. 14, ll. 19-20; col. 4, ll. 41-54; col. 6, ll. 47-49, 52-65; Fig. 1.

11. Central Location

Defendant also accepts Plaintiffs' proposed construction of the term "central location" in Claim 1(a) of the '208 Patent as "a location where electronic coupon data and/or user information is stored." That construction is supported by the claims and specifications. See '208 Patent, col. 14, ll. 11-13, 19-23; col. 4, ll. 40-48.

12. At Least One Server Operatively Associated with the Central Data Repository

This phrase appears in Claim 1 of the '099 Patent in the following context: "at least one server operatively associated with the central data repository for accessing and storing incentive offer and remote user data." '099 Patent, col. 14, ll. 21-23. The specification does not describe the use of a server in this context. Rather, the specification describes only an "online communication server," which operates as a "bulletin board file where users can post messages to a coupon distributor or issuer regarding any issue of interest." See id., col. 8, ll. 39-48; Fig. 6.

Plainly, the definition of server should not be restricted to this definition, because an electronic bulletin board that facilitates communication with a coupon distributor or issuer does not perform the claimed functions of accessing and storing incentive offer and remote user data. The Court therefore must construe the term in accordance with its plain and ordinary meaning to one skilled in the art. Newton's Telecom Dictionary 920 (8th ed. 1994) defines "server" as "a shared computer on the local area network that may be . . . used as a repository and distributor . . . of data." "Operatively associated with the central data repository" shall be construed to mean that the server operates in conjunction with the central data repository.

13. Coupon Data Management Software Module

The term "coupon data management software module" appears in Claims 1(c)(iii) and 1(f) of the '208 Patent as a computer program that is downloaded from the central location to the remote terminal and performs the function of "managing the printing of coupons, including unique user identification information." See '208 Patent, col. 14, ll. 23-26, 43-45. The specification describes other functions performed by the coupon data management software module:

The coupon data management program is implemented by the [remote user] computer for requesting coupon data from the centrally located repository, for storing in the memory coupon data transmitted from the centrally located repository, and for generating printable coupon data from the stored coupon data. The remote user computer also comprises a coupon output buffer operatively associated with the data management program for storing the printable coupon data generated by said coupon data management program.

'208 Patent, col. 4, ll. 48-60.

Additionally, the coupon data management program of the present invention operates in conjunction with the remote computer to allow the

user to select and store certain desired coupon data from the coupon data transmitted by the centrally located repository and print coupons as selected. The coupon data management program also allows the user to generate a shopping list which is correlated to the coupons printed for subsequent redemption.

Id., col. 5, ll. 14-21. Viewing the term in light of the specification, the Court construes “coupon data management software module” to mean a software program downloaded to the remote terminal that performs coupon data management functions, including the printing of coupons.

14. Communication Device

The term “communication device” in Claim 1 of the ‘099 Patent appears in the following context: “at least one communication device in operative association with the server, whereby the central system establishes an electrical communication with a remote terminal operated by a remote user, whereby the central system obtains remote user data, including user-specific information” The Court construes the term in accordance with its plain meaning to mean a component that facilitates the transmission of information or data between the central system and the remote terminal. See McGraw-Hill Dictionary of Scientific and Technical Terms 416, 553 (5th ed. 1994) (defining “communication” as “transmission of intelligence between two or more points over wires or by radio” and “device” as a computer or computer component).

15. Graphical User Interface

The term “graphical user interface” appears in Claims 1 and 21 of the ‘099 Patent in the following context:

a graphical user interface in association with the server and the remote terminal for presenting to the remote user at the remote terminal one or more retailers and one or more incentive offers associated with the

retailers for user selection, the presentation being based at least in part on the user-specific information, whereby the user selects a retailer and one or more incentive offers associated with the user selected retailer, the remote terminal communicating the user selection to the central system, the central system generating a user-specific incentive associated with each selected offer for redemption by the remote user.

'099 Patent, col. 14, ll. 30-41. Defendant argues that the functional language in the claims is unsupported and not enabled by the specification and, therefore, the claims are invalid. The Court here is concerned only with the construction of the disputed claim terms and does not resolve the question of whether the claims are invalid. In the absence of language in the specification interpreting the term "graphical user interface," the Court gives the term its ordinary meaning. The term shall be construed in accordance with Plaintiffs' proposed definition as a "visual computer interface that enables a user to issue commands using a pointing device." See Newton's Telecom Dictionary 488-89 (8th ed. 1994) (defining graphical user interface as a device which "lets users get into and out of programs and manipulate the commands in those programs by using a pointing device (often a mouse)).

16. User Specific Coupons

Defendant accepts Plaintiffs' proposed construction of the term "user specific coupons" in Claim 1 of the '208 Patent as "coupons specific to a user." That construction is supported by the specification. See '208 Patent, col. 5, ll. 46-62; col. 7, l. 62-col. 8, l. 1.

17. Electronic Coupon Information

Defendant accepts Plaintiffs' proposed construction of the term "electronic coupon information" in Claim 1(a) of the '208 Patent as "electronic information relating to coupons." That construction is supported by the claim and specification. See '208 Patent, col. 14, ll. 11-13 ("storing in a storage

device at a central location electronic coupon information pertaining to a group of coupons available”); col. 6, ll. 52-57; Figs. 6 and 10.

18. User Specific Incentives

Defendant accepts Plaintiffs’ proposed construction of the term “user-specific incentives” in Claims 1 and 21 of the ‘099 Patent as “incentives specific to a user.” That construction is supported by the specification and the construction of the term “user specific coupons” in the ‘208 Patent. See, e.g., ‘099 Patent, col. 6, ll. 58-65; col. 7, ll. 51-55.

19. Various Fields; Other Fields; At Least One Other Field Being Variable in Accordance with User-Specific Information

The terms “various fields” and “other fields” appear in the following context in Claim 1(e) of the ‘208 Patent: “the coupon data file comprising various fields, including a redemption amount field and other fields, the redemption amount field being indicative of a discount provided by the coupon, the redemption amount field and at least one other field being variable in accordance with user-specific information associated with the requesting user” The terms also appear in Claims 2 and 28 of the ‘099 Patent with reference to an incentive data file.

The variable coupon data fields are depicted in Fig. 3 and include the expiration date, redemption amount, company and product data, UPC code, redemption address, and offer description. See also ‘208 Patent, col. 11, ll. 24-32. In addition, Fig. 3 depicts various fixed coupon data fields, including the border graphics, redemption instructions, and user identification bar code. The user’s computer assembles coupons for printing by using the fixed coupon data and user-specific information, which are stored on the user’s computer, and variable coupon data, which is transmitted to the user’s

computer when he requests coupon data from the central repository. '208 Patent, col. 5, ll. 6-13; see also col. 10, ll. 58-64. The user-specific information encoded on each coupon in the form of a user identification bar code number is variable as between different users.

Referring to FIG. 3, the data format of the fixed coupon parameters and user-specific data are set forth and include predefined border graphics which are the same for every coupon printed, redemption instructions, and a user identification bar code number. The user identification bar code number is a unique number assigned to that user, e.g. his social security number or online identification number. This number will be encoded by the printable coupon data generation routine 32*d* and printed as a bar code 90 on each coupon 18 printed for the particular user. This information will thus be obtained by the coupon redemption center and provided to the coupon distributor 16 for demographic analysis and the like.

'208 Patent, col. 10, l. 65-col. 11, l. 10. The nature of the offer presented to the user may vary in accordance with demographic information provided by the user:

The amount of the redemption discount included with a coupon downloaded to a user may be varied depending on certain demographic information that the system has about the user. For instance, the system may provide a certain value for known users of a brand (which information it will obtain by demographic inquiry or through previous redemptions in the system), and it may provide [sic] a higher discount in order to provide an incentive to users of a competitive brand. The ability to vary the value of a discount offer in accordance with such demographic and usage data is a unique advantage offered by the system of the present invention and heretofore unavailable in the prior art.

Id., col. 13, ll. 24-35. As Defendant correctly notes, the prosecution history distinguishes the present invention from the prior art: "Notably, the coupon data file comprises a redemption amount field with redemption amount data that is variable prior to transmission in accordance with a profile associated with the user such that users with different profiles may be provided with coupon data files having

different redemption amounts for the same product.” 4/30/98 Amdt. at 17 (adding limitation to pending claim 47).

In light of the prosecution history and the specification, the Court will construe “various fields” to mean fields of data in the coupon data file. “Other fields” shall mean those fields in the coupon data file other than the redemption amount field. “At least one other field being variable in accordance with user-specific information associated with the requesting user” means that at least one field in the coupon data file other than the redemption amount field will change based on a user’s demographic information and/or prior coupon usage information known to the system.

20. Viewing . . . Selected Ones of the Stored Coupons

Claim 1(d) of the ‘208 Patent recites the disputed phrase “viewing, by a remote terminal, selected ones of the stored coupons, the selected coupons being based on user-specific information, which comprises user profile information and/or user usage history information.” In the preferred embodiment, electronic coupon data is stored in a centrally located repository, and requested coupon data packages are downloaded to a user’s remote computer. ‘208 Patent, col. 6, ll. 30-34; col. 8, ll. 29-33. A user subsequently may view the coupons and advertisements previously downloaded by selecting the view function button 52. *Id.*, col. 9, ll. 54-55. That selection will “call the view coupons routine 32*b*, which will access the downloaded coupon data file 30*a* and present it to the user via the display 24.” *Id.*, col. 9, ll. 56-58. Accordingly, the Court will construe the phrase to mean viewing, by a remote terminal, those coupons which are downloaded to the remote terminal.

21. Claims 5 and 31 of the ‘099 Patent

Dependent Claim 5 of the '099 Patent claims "[t]he system of claim 1, wherein the user-specific information includes a zip code, city, state, user address, user name, or user telephone number." Dependent Claim 31 derives from Claim 21 and claims the same additional elements. The claim terms are self-explanatory and must be accorded their ordinary meaning. The Court does not reach Defendant's argument that the claim is overbroad and not enabled or supported by the specification or prosecution history.

III. CONCLUSION

For the foregoing reasons, the Court concludes the following with regard to the construction of the claim terms at issue:

1. The term “user,” as used throughout the Patents, is construed to mean an individual who utilizes the electronic coupon distribution service or system to request and obtain coupons or incentives.
2. The term “remote user” in Claims 1 and 21 of the ‘099 Patent is construed to mean a user who accesses the system using a remote terminal or a remote user computer.
3. The term “remote user data” in Claims 1 and 21 of the ‘099 Patent is construed to mean prior selection and redemption data associated with the remote user.
4. The term “registered user” in Claim 1(c) of the ‘208 Patent is construed to mean a user who has become eligible to utilize the electronic coupon distribution service by joining the service and thus registering with the system.
5. The term “user profile” in Claim 1(c)(i) of the ‘208 Patent is construed to mean a summary of demographic data provided by the user in response to requests during the initial registration process.
6. The term “user profile information” in Claim 1(d) of the ‘208 Patent is construed to mean information in the user profile.
7. The term “unique user identification information” in Claim 1(c)(iii) of the ‘208 Patent is construed to mean information that is stored on a user’s remote terminal that uniquely identifies the user.
8. The term “user usage history information” in Claim 1(d) of the ‘208 Patent is construed to mean data relating to a user’s selection, printing and redemption of coupons over time.
9. The term “user-specific information” in Claims 1(d) and 1(e) of the ‘208 Patent and in Claims 1 and 21 of the ‘099 Patent is construed to mean information specific to a user.

10. The term “central data repository” in Claims 1 and 21 of the ‘099 Patent is construed to mean any centrally located computer system that stores electronic coupon information (including incentive offer data and product redemption coupon data) and remote user data, said computer system comprising one or more computers or Internet sites.
11. The term “central location” in Claim 1(a) of the ‘208 Patent is construed to mean a location where electronic coupon data and/or user information is stored.
12. The phrase “at least one server operatively associated with the central data repository” in Claim 1 of the ‘099 Patent is construed to mean at least one server that operates in conjunction with the central data repository.
13. The term “coupon data management software module” in Claims 1(c)(iii) and 1(f) of the ‘208 Patent is construed to mean a software program downloaded to the remote terminal that performs coupon data management functions, including the printing of coupons.
14. The term “communication device” in Claim 1 of the ‘099 Patent is construed to mean a component that facilitates the transmission of information or data between the central system and the remote terminal.
15. The term “graphical user interface” in Claims 1 and 21 of the ‘099 Patent is construed to mean a visual computer interface that enables a user to issue commands using a pointing device.
16. The term “user specific coupons” in Claim 1 of the ‘208 Patent is construed to mean coupons specific to a user.
17. The term “electronic coupon information” in Claim 1(a) of the ‘208 Patent is construed to mean electronic information relating to coupons.
18. The term “user specific incentives” in Claims 1 and 21 of the ‘099 Patent is construed to mean incentives specific to a user.
19. The term “various fields” as used in Claim 1(e) of the ‘208 Patent and Claims 2 and 28 of the ‘099 Patent is construed to mean fields of data in the coupon data file. The term “other fields” as used in those claims shall mean those fields in the coupon data file other than the redemption amount field.

20. The phrase “at least one other field being variable in accordance with user-specific information associated with the requesting user” in Claim 1(e) of the ‘208 Patent and Claims 2 and 28 of the ‘099 Patent is construed to mean that at least one field in the coupon data file other than the redemption amount field will change based on the user’s demographic information and/or prior coupon usage information known to the system.
21. The phrase “viewing, by a remote terminal, selected ones of the stored coupons” in Claim 1(d) of the ‘208 Patent is construed to mean viewing, by a remote terminal, those coupons which are downloaded to the remote terminal.
22. The phrase “zip code, city, state, user address, user name, or user telephone” in Claims 5 and 31 of the ‘099 Patent are construed in accordance with their ordinary meaning.

IT IS SO ORDERED this 16th day of December 2003.

/s/

Richard D. Bennett
United States District Judge



EXHIBIT B



IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MARYLAND
SOUTHERN DIVISION

BLACK DIAMOND CCT HOLDINGS,
LLC, *et al.*,
Plaintiffs,

v.

COUPONS, INC.,
Defendant.

CIVIL ACTION NO. RDB-02-3701

* * * * *

ORDER

The parties having filed cross-motions for summary judgment and the Court having conducted a hearing on February 3, 2005, and for the reasons set forth in the foregoing Memorandum Opinion, IT IS this 18th day of February, 2005 HEREBY ORDERED that:

1. The Motion for Summary Judgment on Patent Infringement of Plaintiff Black Diamond CCT Holdings LLC and E-Centives, Inc. (collectively "Black Diamond") (Paper No. 221) is DENIED;
2. The Motion for Partial Summary Judgment on No Infringement of Defendant Coupons, Inc. ("Coupons") (Paper No. 225) is DENIED;
3. Defendant Coupons' Motion for Summary Judgment on Invalidity (Paper No. 222) is DENIED;
4. Plaintiff Black Diamond's Motion for Summary Judgment on No Invalidity (Paper No. 228) is DENIED; and

5. The Clerk of the Court transmit copies of this Order and accompanying Memorandum Opinion to counsel for both parties.

/s/

Richard D. Bennett
United States District Judge